

## REMARKS

The Applicants note that all amendments of Claims presented herein are made without acquiescing to any of the Examiner's arguments or rejections, and solely for the purpose of expediting the patent application process in a manner consistent with the PTO's Patent Business Goals (PBG),<sup>1</sup> and without waiving the right to prosecute the amended Claims (or similar Claims) in the future.

### **I. CLAIM REJECTIONS UNDER 35 U.S.C. §112, FIRST PARAGRAPH**

The Examiner has rejected Claims 24-27, 29, 36 and 95 under 112, first paragraph, as allegedly lacking enablement (Office Action, pg. 2). In particular, the Examiner states

“the specification, while being enabling for a method of characterizing prostate cancer in a patient already diagnosed with prostate cancer by detecting the presence or absence of HIP1 in a sample with a nucleic acid probe configured to hybridize to a HIP1 nucleic acid sequence consisting of the nucleic acid sequence of SEQ ID NO:1, wherein the absence of HIP1 in said sample is indicative of PSA non-recurrence and/or recurrence free survival, does not reasonable provide enablement for a method of characterizing prostate cancer in a patient already diagnosed with prostate cancer by detecting the presence or absence of HIP1 in a sample with a nucleic acid probe configured to hybridize to a HIP1 nucleic acid sequence consisting of the nucleic acid sequence of SEQ ID NO:1, wherein the absence or presence of HIP1 is indicative of the stage of said cancer” (Office Action, pg. 2).

The Applicants respectfully disagree with the rejection. Nonetheless, In order to further the business interests of the Applicants and while reserving the right to prosecute the original (or similar) claims in the future, the Applicants have amended Claim 24 to include the elements of the absence of HIP1 being indicative of PSA recurrence or recurrence free survival. As stated by the Examiner (see above), the specification is enabling for such a claim. Accordingly, the Applicants submit that the presently claimed invention is enabled and respectfully request that the rejection be withdrawn.


---

<sup>1</sup> 65 Fed. Reg. 54603 (Sept. 8, 2000).

**CONCLUSION**

If a telephone interview would aid in the prosecution of this application, the Examiner is encouraged to call the undersigned collect at (618) 218-6900.

Dated: 12/18/06

  
\_\_\_\_\_  
Tanya A Arenson  
Reg. No. 47,391

MEDLEN & CARROLL, LLP  
101 Howard Street, Suite 350  
San Francisco, California 94105  
(608) 218-6900